



05 SEP 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Birch, Stewart, Kolasch & Birch, LLP
P.O. Box 747
Falls Church, VA 22040-0747

In re Application of
ASANO, Kenji, et al.
Application No.: 09/856,716
PCT No.: PCT/JP99/06615
Int. Filing Date: 26 November 1999
Priority Date: 27 November 1998
Attorney Docket No.: 0230-0160P

For: LAK ACTIVITY-SCREENING
MATERIALS CONTAINING LENTINUS
EXTRACT OF EDODES MYCELIIUM
AND LAK ACTIVITY-SCREENING
METHODS USING THE EXTRACT

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. §1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 18 November 2002.

BACKGROUND

On 26 November 1999, applicants filed international application PCT/JP99/06615, which claimed a priority date of 27 November 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 08 June 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 November 1999, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 May 2001 (27 May 2001 was a Sunday).

On 25 May 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 28 June 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 28 January 2002, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a combined declaration and power of attorney executed by inventors Kenji Asano and Yukiko Matsuda, a petition for a five month extension of time and the fee for a five month extension of time.

On 17 May 2002, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 18 November 2002, applicants submitted "Renewed Petition Under 37 C.F.R. §1.47(a)" accompanied by the fee for a four month extension of time.

On 13 May 2003, applicants submitted a copy of the 18 November 2002 petition by facsimile.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1), (3) and (4) were previously met.

Item (2) has not been met. To establish refusal to sign the applicant papers, applicants must detail the circumstances of the presentation of the application papers and of the refusal in the statement of facts by the person who presented the application papers to the inventor and/or to whom the refusal was made. MPEP 409.03(d). An express statement that the application papers should not be sent may be sufficient, but the time and place of the refusal must be stated in the statement of facts.

The declaration of attorneys Kurita and Ejiri indicates that the non-signing inventor was sent only the oath and assignment and that the package did not include a complete copy of the application papers, including the specification with claims and drawings.

An express statement that the application papers should not be sent may be sufficient, it is not found to be in this instance. The declaration of Asano and Murakami does not state date and time of the refusal. MPEP 409.03(d). Additionally, the declaration references the Notification of Rupture, provided as attachment 2. If it is attached, an English translation has not been provided.

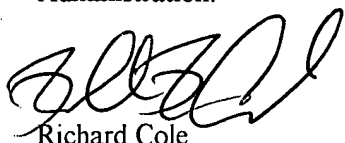
Many pages of foreign language documents accompanied this petition. Most were not translated. Non-translated foreign language documents are not considered.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard Cole
PCT Legal Examiner
PCT Legal Administration



Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 703-305-0455
Facsimile: 703-308-6459